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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,068	10/27/2003	Donald W. Howie	0103-0035(ZM0476)	3820
43231	7590	03/01/2005	EXAMINER	
ZIMMER TECHNOLOGY - REEVES			SNOW, BRUCE EDWARD	
P. O. BOX 1268			ART UNIT	
ALEDO, TX 76008			PAPER NUMBER	
			3738	

DATE MAILED: 03/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/694,068

Applicant(s)

HOWIE ET AL.

Examiner

Bruce E Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 15, 18-24 is/are rejected.
- 7) ☒ Claim(s) 11-14 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Response to Arguments***

Applicant's arguments filed 1/03/05 have been fully considered. Regarding the rejection in view of Carpenter et al, applicant states, "the spacer 40 is wedged into the femoral canal and does not appear to allow for subsidence of the prosthesis 20". The Examiner agrees with the first half of the statement that the positioner (spacer) is wedged into the canal thus providing a means for anchoring the attached femoral hip implant. Regarding the second half of the statement, that it does not allow for subsidence, the Examiner disagrees; the figures clearly show the positioner allowed the hip implant to be implanted into the femoral canal. Regarding the connection between the spacer 40 and the stem 22, see 3:41-54 describing a tapered configuration which locks the elements together.

Regarding the rejection in view of Link et al, applicant notes the tongue in groove connection between the collar and femoral stem. Referring to claim 15 which positively claims the hip implant, it is true to state that the device of Link et al limits upward or downward relative motion between the hip implant and the positioner when implanted. It is also correct to state that positioner permits downward axial motion of the hip implant in the process of implanting the hip implant and stem together. If applicant does not positively claim the hip implant (such as claim 22), the positioner could be used with other femoral hip implants that do not have a tongue. Similar for at least claim 18.

Regarding the rejection in view of Mathys, Sr. et al, applicant cites, "[w]hen the screw 9 is fully threaded.. displacements between the screw 9 and bone as well as the

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*prosthesis collar are prevented.*" The Examiner notes that Mathys is used to reject product claims and not method claims. If the screw was not fully threaded, it when allow for subsidence and limit upward movement of the femoral implant. The device is capable of operating the same as applicant's positioner; applicant's positioner and stem could be placed lower into the femur such that displacements between the positioner and bone as well as the prosthesis are prevented.

The rejection of claim 6 has been withdrawn which positively claims cement not taught by Mathys, Sr. et al.

### ***Allowable Subject Matter***

Claims 11-14 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

It is applicant's duty to assure all claim terminology is supported in the specification.

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 3-5, 7, 15, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Mathys, Sr. et al.

Mathys, Sr. et al teaches a positioner for implantation adjacent a femoral hip implant for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal (retension member, first member), see screw head; and means for anchoring the means for preventing relative to the femoral canal (anchor member, second member), see screw 9.

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Claims 1-4 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Carpenter et al (5,425,768).

Carpenter et al teaches a positioner for implantation adjacent a femoral hip implant for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal Including elements 46 which couples to the stem 22 of the femoral hip implant; and

means for anchoring the means for preventing relative to the femoral canal 62 which are capable of being wedged in the femoral canal providing anchoring and further provide a "means for anchoring" once the cement cures.

Regarding the means for spacing, see element 48.

Regarding claim 24, note 3:2 et seq. teaching that the implant and positioner are inserted into the cement.

Claims 1-10, 15, and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Link et al (4,698,063).

Link et al teaches a positioner for implantation adjacent a femoral hip implant for retaining the femoral hip implant in a femoral canal having a canal wall, the positioner comprising:

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means for preventing the femoral hip implant from rising out of the femoral canal beyond a predetermined position while permitting subsidence of the femoral hip implant down into the femoral canal Including elements 10 and serrations;

and means for anchoring the means for preventing relative to the femoral canal 13 and the other serrations the stem.

Regarding claim 6, see the serrations on the hip implant.

The spacing elements/means/etc. include elements 13 and the fins on which the serrations are on. See figure 2 showing anterior and posterior fins.

Regarding claims 7 and 15, see first member 10 and second member 13.

Claim 18, "retention member" is element 10.

Claim 22, elements 13 and 10 form a symmetrical "L" shape.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be 'Bruce Snow', with a long, sweeping horizontal line extending to the right.

BRUCE SNOW  
PRIMARY EXAMINER